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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,822	12/28/2000	Michael Wayne Nelson	CSCS-3804	8487

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WAGNER, MURABITO & HAO LLP  
Third Floor  
Two North Market Street  
San Jose, CA 95113

EXAMINER
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VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/751,822

Applicant(s)

NELSON ET AL.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Application History*

1. This action is responsive to application amendment, filed on 7/27/2004.
2. Applicant has amended claims 3-6, 9, 12-15, 18, 21-24, 27, 30-33 and 36.
3. Claims 1-36 are pending in the case, claims 1, 10, 19 and 28 are independent claims.
4. Applicant has amended the drawings and specification in response to the objections cited by the examiner in the *Drawings* and *Specification* sections of the previous office action (dated 4/22/2004). Applicant's amendment has addressed the objections previously made, and therefore, in view of the amendment, objections to the drawings and specification are withdrawn.
5. Examiner's rejection of claims 3-6, 9, 12-15, 18, 21-24, 27, 30-33 and 36, made under 35 USC 112 in the *Claim Rejections – 35 USC 112* section of the previous office action (dated 4/22/2004) is withdrawn in view applicant's amendment.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*"A person shall be entitled to a patent unless –*

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."*

7. Claims 1-36 remain rejected under 35 U.S.C. 102(e) as being anticipated by Spencer US Patent 6,356,909 (filed 8/23/1999, patented 3/12/2002).

8. **Regarding independent claim 1**, Spencer recites: *"Using templates for predetermined RFP types (step 23), RFP creators can quickly choose a template that enables them to begin creating a client specific RFP. After the template or an existing RFP is selected, the user may review the RFP to add or delete appropriate sections or questions, as shown in step 24"* (column 12, lines 34-38). Spencer further recites: *"In one embodiment of the present invention, the system and method provide RFP creators with the capability to capitalize on previously developed RFP's and specific questions within each RFP using a question database and a RFP database accessible through the web site interface"* (column 3, lines 26-31). Spencer further discloses

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selecting the sequence of sections in Figure 4 at reference sign 28, shown as *"Organize RFP"*.

9. **Regarding dependent claims 2-6**, Spencer discloses a database used to store content in Figure 3A at reference signs 2-7, shown as *"Question Database"*, *"Analysis Database"*, *"Response Database"*, *"Client Database"*, *"User Database"* and *"RFP Database"*. Spencer further discloses in Figure 3C, at reference signs A, B and C, lists of content that is selectable subject matter.
10. **Regarding dependent claims 7**, Spencer discloses in Figure 4 creating a new template at reference sign 21 (shown as *"Create Brand New RFP"*).
11. **Regarding dependent claims 8**, Spencer recites: *"This allows users to prepare reports at any time during the process. Any additional information that may be needed is generated. This allows users to output all of the data into the format of their choice or use the internal system tools to generate reports/results"* (column 16, lines 47-49).
12. **Regarding dependent claim 9**, the claim is directed toward substantially the same subject matter as claim 2, and is rejected with the same rationale.
13. **Regarding claims 10-18 and 28-36**, the claims are directed toward a system for the method of claims 1-9, and are rejected with the same rationale.

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14. **Regarding claims 19-27**, the claims are directed toward a computer readable medium for the method of claims 1-9, and are rejected with the same rationale.

### ***Response to Arguments***

15. Applicant's arguments filed 7/23/2004 have been fully considered but they are not persuasive.

16. **Regarding independent claims 1, 10, 19 and 28**, applicant states: *"Spencer does not anticipate or render obvious a method for generating a plurality of templates that include "displaying to the user said selected template, wherein said selected template enables a user to select said sections, sub-sections and fields for inclusion in a particular document to be built" as is recited in Claim 1 (claims 10, 19 and 28 recite similar limitations)"* (page 17, last paragraph). Applicant is directed to the rejection of claim 1 as restated above.

In further support of the rejection, Spencer recites: *"Using templates for predetermined RFP types (step 23), RFP creators can quickly choose a template that enables them to begin creating a client specific RFP. After the template or an existing RFP is selected, the user may review the RFP to add or delete appropriate sections or questions, as shown in step 24"* (column 12, lines 34-38).

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17. **Also, Regarding independent claims 1, 10, 19 and 28**, applicant states:

*"Claim 1 requires that the users be enabled to select different types of template sections for inclusion in the document that is built"* (page 18, first paragraph).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *"template sections"*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### **Conclusion**

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**STEPHEN HONG**  
**SUPERVISORY PATENT EXAMINER**

Gregory J. Vaughn  
January 7, 2005